



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,636	04/09/2004	Scott E. Williams	005127.00226	9029
22909 7590 05/14/2009 BANNER & WITCOFF, LTD. 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051			EXAMINER QUINN, RICHAE LEE	
			ART UNIT 3765	PAPER NUMBER
			MAIL DATE 05/14/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/821,636	Applicant(s) WILLIAMS ET AL.	
	Examiner RICHALE L. QUINN	Art Unit 3765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30, 32, and 34-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30, 32 and 34-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 November 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/9/2009 has been entered.

Claims 1, 12, 18, 24, 30, 34, 41 were amended. Claims 31 and 33 are cancelled. Claims 1- 30, 32, and 34- 48 are currently pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 – 4 and 41 – 43 are rejected under 35 U.S.C. 102(b) as being anticipated by Watson, Jr. (US 5,692,238). The device of Watson, Jr. discloses an article of apparel for moderating body temperature of an individual. The apparel article comprising a torso region having a chest area, a back area opposite the chest area, and two opposing side areas that interconnect at least one of the sides of the back area to at least one side of the chest area (Figure 3). A pair of shoulder areas (Figure 3) interconnect the top side of the chest area with the top side of the back area. The chest

Art Unit: 3765

areas, the back area, the two opposing side areas and the shoulder areas define a space for receiving the torso of an individual. A plurality of cavities (35) are distributed throughout the torso region, the cavities being provided in the chest area, the back area, around each of the side areas, and at or near the top of the shoulder areas. The plurality of cavities (35) includes a first cavity positioned in a first of the opposing side areas (43), the first cavity extending around a first side of the torso region and a second cavity positioned in a second of the opposing side areas (45), the second cavity extending around a second side of the torso region (See Figure 3). A fitting system (Column 2, lines 50 -55) extending at least partially around the torso region to ensure contact between the individual and at least one of the chest areas, the back area, and the side areas. The article has a vest (Figure 3) configuration. Thermal inserts (5) are positioned in the cavities. The thermal inserts are bladders that enclose a fluid (Column 2, lines 23 – 25).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 5, 6, 30, 32, 44 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watson, Jr. in view of Steele et al. (US 5,146,625). The device of Watson discloses a garment for wearing and moderating body temperature of an

Art Unit: 3765

individual comprising selecting an article of apparel (Figure 3), cooling the gel packs (column 2, lines 23 – 28) at least a portion of the article of apparel that includes cooling a plurality of inserts that are positioned within the cavities so that at least one of the cavities is positioned around the side areas of the torso (43,45). In regard to method claims 30 and 32, the device of Watson, Jr. does not disclose a garment that is worn during first and second periods of time while participating in a first sedentary activity and a second non-sedentary activity and removing the garment. It is noted that the device of Watson, Jr. is capable of being worn during any type of physical activity performed by the person wearing the garment, such as walking vs. sitting. The recitation of performing an activity relates to the person wearing the garment and not the garment itself and is therefore considered a functional recitation. It is understood that the garment can be removed at the discretion of the wearer. The device of Watson, Jr. substantially discloses the claimed invention but is lacking an insert having multiple chambers filled with water. The device of Steele et al. discloses a thermal insert for a vest having multiple chambers within (52) filled with water (Column 3, lines 55- 60) which are cooled in a freezer (Column 3, lines 65 – 69) to keep the wearer cold during activities (Column 4, lines 20). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Watson, Jr. by incorporating multiple chambers as taught by Steele et al. in order to allow easier use of flexing (Column 4, lines 43 – 45). The combination of Watson, Jr. and Steele et al. meet all of the structural limitations claimed by applicant and is inherently capable of performing the method described by applicant.

Art Unit: 3765

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watson, Jr. in view of Lesley (US 2002/0152533). The device of Watson, Jr. substantially discloses the claimed invention but is lacking an access opening extending in the vertical direction through the chest or back areas. The device of Lesley discloses a vest having a vertical access opening (22) located through the chest portion. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the device of Watson, Jr. with the access opening taught by Lesley in order to increase the ease of donning the vest.

7. Claims 8 – 15, 18 - 20, 22 – 25, 28 - 29, 34 – 36, 38 - 40, and 46 – 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watson, Jr. in view of The Federal Trade Commissions Rules. The device of Watson, Jr. substantially discloses the claimed invention but is lacking pictorial instructions that are permanently secured to the interior of the garment. According to the Care Labeling Rule, care instructions must be permanently secured to the inside of textile wearing apparel. Effective, July 1, 1997 the Federal Trade Commission permits the use of symbols, in place of written instructions, to provide instruction as to the method of cleaning. Care symbols developed by the American Society of Testing and Materials (ASTM) show pictorial representation for utilizing the garment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to permanently secure pictorial instructions to the textile apparel garment of Watson, Jr., since it is a federally mandated regulation. In regard to the instructions directing the individual to follow specific steps it is the position of the examiner that the limitations specifying how the

Art Unit: 3765

garment is used is functional. A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

8. Claims 16, 17, 26, 27, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watson, Jr. and The Federal Trade Commission as applied to claims 8 – 15, 18 - 20, 22 – 25, 28 - 29, 34 – 36, 38 - 40, and 46 – 48 above, and further in view of Steele et al. (US 5,146,625). The modified device of Watson, Jr. substantially discloses the claimed invention but is lacking an insert having multiple chambers filled with water. The device of Steele et al. discloses a thermal insert for a vest having multiple chambers filled with water (Column 3, lines 55 – 60) within (52). It would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the device of Watson, Jr. by incorporating multiple chambers as taught by Steele et al. in order to allow easier use of flexing (Column 4, lines 43 – 45).

9. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watson, Jr. and The Federal Trade Commission as applied to claims 8 – 15, 18 - 20, 22 – 25, 28 - 29, 34 – 36, 38 - 40, and 46 – 48 above, and further in view of Lesley (US 2002/0152533). The modified device of Watson, Jr. substantially discloses the claimed invention but is lacking an access opening extending the vertical direction through the chest or back areas. The device of Lesley discloses a vest having a vertical access opening (22) located through the chest portion. It would have been obvious to a person

Art Unit: 3765

having ordinary skill in the art at the time the invention was made to modify the device of Watson, Jr. with the access opening taught by Lesley in order to increase the ease of donning the vest.

Response to Arguments

Applicant's arguments with respect to claims 1-30, 32, and 34 - 48 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RICHALE L. QUINN whose telephone number is (571)272-8689. The examiner can normally be reached on M-F 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Welch can be reached on 571-272-4996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3765

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Richale L Quinn
Examiner
Art Unit 3765

/R. L. Q./
Examiner, Art Unit 3765

/KATHERINE MORAN/
Primary Examiner, Art Unit 3765